

ESTTA Tracking number: **ESTTA768688**

Filing date: **09/06/2016**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Scandinavian Tobacco Group Assens A/S
Granted to Date of previous extension	09/03/2016
Address	Tobaksvej 1 5610 Assens, DENMARK
Attorney information	Scott Greenberg Locke Lord LLP Brookfield Place, 200 Vesey Street New York, NY 10281 UNITED STATES ptotmcommunication@lockelord.com,sgreenberg@lockelord.com

Applicant Information

Application No	87027656	Publication date	07/05/2016
Opposition Filing Date	09/06/2016	Opposition Period Ends	09/03/2016
Applicant	Yuri Gagarin LLC 1401 Prospect Avenue #511 Cleveland, OH 44115 UNITED STATES		

Goods/Services Affected by Opposition

Class 034. First Use: 2016/03/13 First Use In Commerce: 2016/04/13 All goods and services in the class are opposed, namely: Ashtrays; Cigar boxes; Cigar cases; Cigar cutters; Cigar holders; Cigar humidifiers; Cigar tubes; Humidors; Lighters for smokers; Cigar lighters; Holders for cigars and cigarettes; Smokers' articles,namely, cigar storage tubes; Smoking pipes
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Grounds for Opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
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Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	972740	Application Date	04/10/1972
Registration Date	11/13/1973	Foreign Priority Date	NONE
Word Mark	LA GLORIA CUBANA		
Design Mark			

Description of Mark	NONE
Goods/Services	Class 034. First use: First Use: 1972/04/01 First Use In Commerce: 1972/04/01 CIGARS

U.S. Registration No.	2264290	Application Date	11/20/1997
Registration Date	07/27/1999	Foreign Priority Date	NONE

Word Mark	LA GLORIA CUBANA
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Design Mark	
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Description of Mark	NONE
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Goods/Services	Class 034. First use: First Use: 1983/00/00 First Use In Commerce: 1983/00/00 Cigars made from Cuban seed tobacco
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U.S. Registration No.	2264499	Application Date	03/02/1998
Registration Date	07/27/1999	Foreign Priority Date	NONE

Word Mark	LA GLORIA CUBANA
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Design Mark	
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Description of Mark	NONE
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Goods/Services	Class 034. First use: First Use: 1983/00/00 First Use In Commerce: 1983/00/00 Cigars made from Cuban seed tobacco
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Attachments	75393561#TMSN.png(bytes) 75442377#TMSN.png(bytes) Notice of Opposition.pdf(208960 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Scott Greenberg/
Name	Scott Greenberg
Date	09/06/2016

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of:

Application Serial No. 87/027656 for the mark LA CUBANA and Design
Published: July 5, 2016

SCANDINAVIAN TOBACCO GROUP ASSENS A/S

Opposer,

v.

YURI GAGARIN LLC

Applicant.

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Opposition No. _____

NOTICE OF OPPOSITION

Yuri Gagarin LLC (hereinafter “Applicant”) has applied to register the mark LA CUBANA and Design.

The subject application for LA CUBANA and Design, Serial Number 87/027656, was published for opposition in the Official Gazette of July 5, 2016 and covers the following goods: Ashtrays; Cigar boxes; Cigar cases; Cigar cutters; Cigar holders; Cigar humidifiers; Cigar tubes; Humidors; Lighters for smokers; Cigar lighters; Holders for cigars and cigarettes; Smokers' articles, namely, cigar storage tubes; Smoking pipes, in International Class 34.

Scandinavian Tobacco Group Assens A/S, a company organized and existing under the laws of Denmark, having a business address at Tobaksvej 1, 5610 Assens, Denmark, believes that it will be damaged by registration of the mark shown in Application Serial Number 87/027656 as applied to said goods and hereby opposes the same.

As grounds for opposition, it is alleged that:

1. Scandinavian Tobacco Group Assens A/S (hereinafter, including its predecessors and related companies, “Opposer”) is and for many years has been engaged in the business of manufacturing and distributing cigars and related products throughout the United States and numerous jurisdictions around the world.

2. Since a time long prior to the filing date of the opposed application and the date of first use alleged by Applicant, Opposer has used the mark LA GLORIA CUBANA in commerce in connection with its cigar products and accessories for cigars. Opposer’s LA GLORIA CUBANA cigars are one of its bestselling brands of premium cigar.

3. Opposer’s LA GLORIA CUBANA mark has been extensively advertised and promoted in commerce, and has received extensive third-party publicity.

4. Opposer is the owner, inter alia, of the following United States trademark registrations:

MARK	REG. NO.	REG. DATE	GOODS/CLASS
LA GLORIA CUBANA	972,740	04/10/1972	Cigars, Class 34
LA GLORIA CUBANA and Design	2,264,290	07/27/1999	Cigars made from Cuban seed tobacco, Class 34
LA GLORIA CUBANA and Design	2,264,499	07/27/1999	Cigars made from Cuban seed tobacco, Class 34

5. Said registrations listed above are valid and subsisting, uncanceled and unrevoked. In addition, all of the registrations listed above have become incontestable under 15 U.S.C. Section 1065.

6. Opposer has used the LA GLORIA CUBANA mark covered by the above registrations (the “LA GLORIA CUBANA Mark”) in commerce since a long time prior to the filing date of the opposed application and the date of first use alleged by Applicant.

7. Opposer's LA GLORIA CUBANA Mark is inherently distinctive and is highly distinctive to relevant purchasers. The LA GLORIA CUBANA Mark is widely and favorably known to the trade and public.

8. Through Opposer's extensive use of its LA GLORIA CUBANA Mark to advertise and promote Opposer's goods, the public has come to recognize said mark in connection with cigars and related goods as being uniquely associated with Opposer. Opposer has developed, at great effort and expense, extremely valuable goodwill with respect to its LA GLORIA CUBANA Mark.

9. As a result of all of the foregoing activity, Opposer's LA GLORIA CUBANA Mark is famous and has been famous since a long time prior to the filing date of the opposed application and the date of first use alleged by Applicant.

10. The LA GLORIA CUBANA Mark is of great value to Opposer and serves to identify high quality products originating with Opposer and to distinguish Opposer's products from those of others. Opposer is the owner of the LA GLORIA CUBANA Mark and the underlying goodwill in connection therewith.

11. With the opposed application, Applicant seeks to register the mark LA CUBANA and Design for "Ashtrays; Cigar boxes; Cigar cases; Cigar cutters; Cigar holders; Cigar humidifiers; Cigar tubes; Humidors; Lighters for smokers; Cigar lighters; Holders for cigars and cigarettes; Smokers' articles, namely, cigar storage tubes; Smoking pipes", in Class 34.

12. The opposed application for the mark LA CUBANA and Design was filed on May 6, 2016.

13. The opposed application for the mark LA CUBANA and Design alleges a date of first use of March 13, 2016 and first use in commerce of April 13, 2016.

14. “Ashtrays” are accessories for cigars.
15. “Cigar boxes” are accessories for cigars.
16. “Cigar cases” are accessories for cigars.
17. “Cigar cutters” are accessories for cigars.
18. “Cigar holders” are accessories for cigars.
19. “Cigar humidifiers” are accessories for cigars.
20. “Cigar tubes” are accessories for cigars.
21. “Humidors” are accessories for cigars.
22. “Lighters for smokers” are accessories for cigars.
23. “Cigar lighters” are accessories for cigars.
24. “Holders for cigars” are accessories for cigars.
25. “Smokers' articles, namely, cigar storage tubes” are accessories for cigars.
26. “Holders for cigarettes” are accessories for tobacco smoking products.
27. “Smoking pipes” are accessories for tobacco smoking products.
28. Cigars and the goods identified in the opposed application are distributed and marketed in overlapping channels of trade.
29. Cigars and the goods identified in the opposed application are sold in the same retail establishments.
30. Cigars and the goods identified in the opposed application are purchased by the some of the same consumers.
31. Opposer would be damaged by the registration of the mark LA CUBANA and Design in that said mark so closely resembles Opposer’s LA GLORIA CUBANA Mark, as to be likely, when applied to the goods of Applicant, to cause confusion, mistake and deception, with

consequent damage to Opposer's business and goodwill, and such registration will otherwise give color of the right to use, exclusive ownership and other statutory benefits in the mark LA CUBANA and Design to Applicant in violation and derogation of the prior and superior rights of Opposer.


32. Registration should, therefore, be refused pursuant to Section 2(d) of the Trademark Act of 1946, as amended (15 U.S.C. Section 1052(d)) on the ground that Applicant's mark LA CUBANA and Design so resembles Opposer's LA GLORIA CUBANA Mark, as to be likely, when applied to the goods of the Applicant, to cause confusion, mistake or deception.

WHEREFORE, Opposer respectfully requests that its Opposition be sustained and that the application to register the mark in Application Serial Number 87/027656 be denied.

The filing fee for this opposition is being filed online.

Dated: September 6, 2016

By:



Scott Greenberg
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New York, New York 10281
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Attorneys for Scandinavian Tobacco Group Assens A/S

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing Notice Of Opposition was served on Applicant by mailing said copy on September 6, 2016, via First Class Mail, postage prepaid, to Applicant's attorney and correspondent of record as follows:

Francis John Ciaramella, Esq.
RICK RUZ, PLLC
300 Sevilla Avenue, Suite 301
Coral Gables, Florida 33134



Scott Greenberg